

Remarks/Arguments

Claims 1 to 3, 8, 9, 11, 16 to 18 and 20 to 22 are presently pending. Claims 4 to 7, 10, 12 to 15 and 19 are cancelled, without prejudice. Claims 1 to 3, 8, 9 and 16 to 17 have been amended, without prejudice. Applicants reserve the right to pursue subject matter that remains after the prosecution of the present application in a future continuing patent application, for example, a division.

Discussion of the Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1 to 3, 11 and 16 to 18 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite with regard to the definitions of "L" and "M". Although applicants disagree, it is respectfully submitted that this rejection is overcome in view of the amendment to claim 1 wherein formula I now includes a L as a bond and M as $-\text{CH}_2-\text{CH}_2-$.

Discussion of the Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1 to 3, 11 and 16 to 18 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement for compounds other than those exemplified in tables 2 and 4. Applicants traverse respectfully this rejection because the Action has not met its burden of establishing a reasonable basis to question the enablement provided for the claimed invention.

It is settled law that whenever the adequacy of enablement provided by an applicant's specification is challenged, the examiner has the initial burden of giving reasons, supported by the record as a whole, why the specification is not enabling. *In re Armbruster*, 185 U.S.P.Q. 152 (C.C.P.A. 1975). The enablement requirement of 35 U.S.C. § 112 is satisfied if a disclosure contains sufficient information such that persons of skill in the art, having the disclosure before them, would be able to make and use the invention. The legal standard for enablement under § 112 is whether one skilled in the art would be able to practice the invention without undue experimentation. *In re Wands*, 8 U.S.P.Q. 1400 (Fed. Cir. 1988). Any experimentation that may be required is not undue as long as it is of a routine nature. *Ex parte Forman*, 230 U.S.P.Q. 546, 547 (Pat. Off. Bd. App. 1986). As the Federal Circuit noted:

The test [for undue experimentation] is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed to enable to determination of how to practice a desired embodiment of the claimed invention. *PPG Indus., Inc. v. Guardian Indus. Corp.*, 37 U.S.P.Q.2d 1618, 1623 (Fed. Cir. 1996) (quotation and citation omitted).

In the first instance, applicants' disclosure indeed contains sufficient information to allow persons skilled in the art to make and/or use the claimed compounds. For example, pages 7 to 9 detail methods of preparing the claimed compounds, with 36 examples of specific compounds

prepared in tables 2 and 4 on pages 20 to 22, 26 and 27. Further, pages 14 to 19 detail methods of using the claimed compounds. Such disclosure is indeed supportive of enablement of the claimed compounds. Accordingly, any experimentation that may be required would not be undue in view of said teachings. *Ex parte Forman*, 230 U.S.P.Q. 546, 547 (Pat. Off. Bd. App. 1986).

Moreover, the Action has failed to satisfy its burden to provide evidence of a reason to doubt that those skilled in the art would be unable to practice applicants' claimed invention. With regard to the enablement determination, the following statement from *In re Marzocchi*, 169 U.S.P.Q. 367, 369-70 (C.C.P.A. 1971), is noteworthy:

The only relevant concern of the Patent Office under these circumstances should be over the truth of any assertion. The first paragraph of § 112 requires nothing more than objective enablement. How such a teaching is set forth, either by use of illustrative examples or by broad terminology, is of no importance.

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirements of the first paragraph of §112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied upon for enabling support.

The law thus requires that the Patent Office accepts applicants' assertions of enablement or provide reasoning and evidence to substantiate doubts of the objective truth of applicants' assertions. *In re Dinh-Nguyen*, 181 U.S.P.Q. 46 (C.C.P.A. 1974); *In re Bowen*, 181 U.S.P.Q. 48 (C.C.P.A. 1974).

The Action, however, has provided no factual evidence indicating a reason to doubt that applicants' disclosure would enable those skilled in the art to prepare and use the claimed compounds. The Action, for example, expresses doubt that unexemplified claimed compounds could be prepared, but provides no evidence as to how and why the teachings in applicants' specification are not true such that the claimed compounds would not be enabled. Although the 36 working examples do not cover the entire scope of the claims, this cannot be the sole reason for rejecting claims as being broader than the enabling disclosure, but merely a factor to be considered along with all the other factors. See MPEP § 2164.02. Accordingly, the Action has failed to satisfy its burden to provide evidence of a reason to doubt that those skilled in the art would be unable to practice applicants' claimed invention. Absent some reason to doubt the truth of statements made in applicants' disclosure regarding enablement, practice of the pending claims must be deemed enabled. *In re Wright*, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993).

Discussion of the Rejection under 35 U.S.C. § 102(f), (g)

Claims 1 to 3, 11, and 16 to 18 are rejected under 35 U.S.C. § 102(f),(g) as allegedly anticipated by U.S. Patent No. 7,399,861 to Bodor ("Bodor"). Applicants respectfully traverse this rejection.

Section 102(f) provides that a person shall be entitled to a patent unless "he did not himself invent the subject matter sought to be patented". Section 102(g) provides that a person shall be entitled to a patent unless "before such person's invention thereof, the invention was made in this country by another inventor ...".

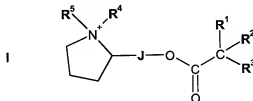
The present application was filed on May 15, 2006 as a National Stage Entry of PCT/EP04/06795, filed on June 23, 2004 (the PCT application), which claims priority benefit of Great Britain Appln. Nos. 0314697.4 and 0327526.0, filed respectively on June 24, 2003 and November 26, 2003. Based at least on the PCT application, the present application antedates Bodor, which was filed on November 13, 2006, and claims priority of U.S. Provisional Appln. Nos. 60/735,206 and 60/735,207, both filed on November 10, 2005. As such, Bodor cannot be used as the basis for a rejection under Section 102(f)/102(g) for at least this reason. Reconsideration and withdrawal of the rejection is requested.

Discussion of the Rejection under 35 U.S.C. § 102(e)

Claims 1 to 3, 11, and 16 to 18 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by International Publication No. WO03/087094 to Prat et al. ("Prat") as supplemented by CA139:337885. Applicants respectfully traverse this rejection because Prat does not disclose each and every element of the presently claimed invention.

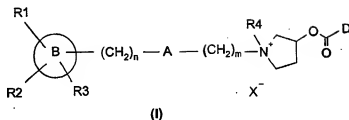
For a reference to anticipate a claim under 35 U.S.C. § 102, "the identical invention must be shown in as complete detail as is contained in the ... claim" (*Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). Further, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (*Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Applicants claims define a compound of formula I



wherein, in part, J is C₁-C₂-alkylene. See, e.g., claim 1.

Prat discloses compounds of Formula I

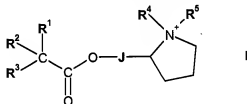


See, e.g., page 2. Thus, at least two differences between the claimed invention and Prat is that (1) the present invention discloses 1,1,2-substituted pyrrolidines whereas Prat discloses 1,1,3-substituted pyrrolidines; and (2) the claimed invention has a J C₁-C₂-alkylene group between the pyrrolidine and the -O-CO-C(R¹)(R²)(R³) group whereas Prat has no such J group between the pyrrolidine and the -O-CO-D group. Prat therefore does not disclose each and every element of the presently claimed invention. Reconsideration and withdrawal of the rejection is respectfully requested for at least this reason.

Discussion of the Rejection under 35 U.S.C. § 103(a)

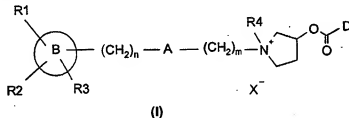
Claims 1 to 3, 8 to 9, 11, and 16 to 18 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Prat in view of U.S. Patent No. 6,846,835 to Ogino et al. ("Ogino"). Applicants respectfully traverse this rejection as there is no reason or motivation for a person of ordinary skill in the art at the time of the present invention to modify the combination of Prat and Ogino in such a way as to obtain the presently claimed invention.

As noted above, Applicants claims define a compound of formula I



wherein, in part, J is C₁-C₂-alkylene; and further wherein R¹ and R³ are each independently a C₃-C₁₅-carbocyclic group or a 5- to 12-membered heterocyclic group having at least one ring heteroatom selected from nitrogen, oxygen and sulphur; and R² is hydrogen, hydroxy, or C₁-C₄-alkyl optionally substituted by hydroxy. See, e.g., claim 1.

As also noted above, Prat discloses compounds of Formula I

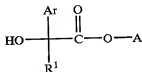


wherein, in part, D may comprise -C(R₉)(R₁₀)(R₁₁); R₉ is phenyl, 2-furyl, 3-furyl, 2-thienyl or 3-thienyl; R₁₀ is phenyl, 2-furyl, 3-furyl, 2-thienyl, 3-thienyl or C₃-C₇cycloalkyl; and R₁₁ is

hydrogen, hydroxy, methyl, or $-\text{CH}_2\text{OH}$. See, e.g., pages 2 to 3. Prat at least does not disclose the 1,1,2-substitution or the $\text{J C}_1\text{-C}_2$ -alkylene group between the pyrrolidine and the $-\text{O-CO-C(R}^1\text{)(R}^2\text{)(R}^3\text{)}$ group of the presently claimed pyrrolidines. Prat does not provide any reason or suggestion that would motivate one of ordinary skill in the art to modify Prat in such a way as to obtain the presently claimed compounds.

Ogino discloses compounds of formula 1

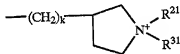
(1)



wherein A can be a compound of formula a_2

(a_2)

X^+



wherein k is 0, 1 or 2; and R^1 is a fluorine-substituted $\text{C}_4\text{-C}_6$ cycloalkyl optionally having hydroxyl groups. See Ogino at Col. 2, lines 1 to 33, Col. 7, lines 40 to 67. Thus, at least two differences between the claimed invention and Ogino is that (1) the present invention discloses 1,1,2-substituted pyrrolidines whereas Ogino discloses 1,1,3-substituted pyrrolidines; and (2) the claimed invention does not have a fluorine-substituted $\text{C}_4\text{-C}_6$ cycloalkyl group as either R^1 , R^2 or R^3 whereas Ogino requires such a group as R^1 . Ogino does not provide any reason or suggestion that would motivate one of ordinary skill in the art to modify Ogino in such a way as to obtain the presently claimed compounds.

The Action appears to link the alleged structural similarity of applicants' claimed invention to those disclosed in Prat and Ogino in an attempt to establish that the present claims are obvious. This, however, falls far short of providing the requisite motivation because it has not been shown why one of ordinary skill in the art would modify both Prat and Ogino by changing the substitution pattern of the pyrrolidines disclosed therein, and modifying Prat by inserting Ogino's $(\text{CH}_2)_k$ group between Prat's pyrrolidine and $-\text{O-CO-D}$ group yet not also not modifying Prat's R^{10} $\text{C}_3\text{-C}_7$ cycloalkyl with Orino's R^1 fluorine-substituted $\text{C}_4\text{-C}_6$ cycloalkyl group so as to obtain the presently claimed compounds.

Moreover, although it would have been theoretically possible to modify Prat in a way that would have produced the claimed invention, much more is required of a reference that is applied in the context of Section 103. The mere possibility that the prior art can be modified or improved does not itself provide the requisite motivation to do so. *In re Dien*, 152 U.S.P.Q. 550 (C.C.P.A. 1967) (incentive to seek improvement of existing process held to not render change

made by applicant obvious, even where the change was one capable of being made from theoretical point of view). The mere possibility for modification and improvement is not the "motivating force" that the Board and the Federal Circuit have invariably required. If it were, then no modification would ever lack motivation since some change is always possible.

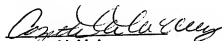
Indeed, the Patent Office has the burden of presenting factual evidence that would indicate that the claimed compounds are prima facie obvious. *In re Lunsford*, 148 U.S.P.Q. 721 (C.C.P.A. 1966). In the absence of such a showing, such a rejection is based upon the impermissible use of hindsight in combination with the benefit of applicants' disclosure. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) ("it is impermissible for an Examiner, in proffering a 35 U.S.C. § 103 rejection, to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art to render the claimed invention obvious"). Accordingly, reconsideration and withdrawal of the above rejections are requested respectfully for at least this reason.

Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the Action of record. If there are any issues that can be resolved by a telephone conference, the Examiner is invited to telephone the undersigned attorney.

The Commissioner is hereby authorized to charge any fees required to Deposit Account No. 19-0134 in the name of Novartis.

Respectfully submitted,



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